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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/504,304	02/15/00	PORTMAN	R 1458P

MM91/0606

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EXAMINER

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ART UNIT	PAPER NUMBER
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2841

DATE MAILED: 06/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/504,304

Applicant(s)

PORTMAN ET AL.

Examiner

Thanh S Phan

Art Unit

2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☒ Claim(s) 6, 12, 15 and 19 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 February 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters " 40' " and " 40" " have both been used to designate connector 40. Correction is required.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "32" and "42" have both been used to designate LED. Correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The term "backside" in claims 6, 12, 19, 25 is not defined by the specification.

The claims recite that "...the LED is soldered to the backside of the surface mount connector." It is not understood which side of the connector that the LED is soldered to. It appears from Figure 5(a) that the LED is soldered to the top side of the surface mount connector 40. The backside appears to have the sockets.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7-10, and 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Yagi (U.S Pat # 4,667,270).

Regarding claim 1, Yagi discloses a removable visual structure (Figure 1, elements 10, 18) comprising:

A removable connection portion (18); and

A visual indication portion (10) coupled to the removable connection portion, wherein the visual indication structure can be removably attached to a printed circuit board (Figure 1, element 36).

Regarding claim 2, Yagi discloses a removable visual indication structure comprises an LED (Figure 1, element 10).

Regarding claim 3, Yagi discloses that the LED comprises a surface mount LED (Figure 1, element 10).

Regarding claim 4, Yagi discloses that the removable visual structure wherein the removable connection portion comprises a surface mount connector (Figure 1, element 18).

Regarding claim 7, Yagi discloses a removable visual indication structure for use with a printed circuit board (Figure 1, elements 10, 18, 36) comprising:

A removable connector (18) adapted to be attached to the printed circuit board (36); and at least one visual indicator (10) coupled to the removable connector.

Regarding claim 8, Yagi discloses the visual indication structure comprises an LED (Figure 1, element 10).

Regarding claim 9, Yagi discloses a removable visual indication structure wherein the LED comprises a surface mount LED (Figure 1, element 10).

Regarding claim 10, Yagi discloses a removable visual indication structure wherein the removable connector comprises a surface mount connector (Figure 1, element 18).

Regarding claims 13-17, Yagi discloses a printed circuit board system (Figure 1) comprising;

A printed circuit board (element 36);

At least one pin coupled to the printed circuit board (element 20 between elements 42); and at least one removable visual indication structure coupled to the at least one pin (element 10).

At least one removable visual indication structure comprises: a removable connector (element 18) adapted to be attached to the printed circuit board; and at least one visual indicator (element 10) coupled to the removable connector.

At least one visual indicator comprises an LED (element 10).

The LED comprises a surface mount LED (element 10).

The removable connector comprises a surface mount connector (element 18).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6, 11-12, 18-19, and 20-25 rejected under 35 U.S.C. 103(a) as being unpatentable over Yagi.

Yagi does not disclose that the LED is soldered to the surface mount connector, however, it involves no invention to cast in one piece an article which has formerly been cast in two pieces and put together. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Regarding claims 20-25, the method steps are necessitated by a light indicator structure to a printed circuit board as it is disclosed by Yagi as mentioned above.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Engels et al. (U.S. Pat # 5,396,086) discloses an LED Spacer Assembly.

Heeb et al. (U.S. Pat # 5,612,855) discloses an Adapter For Mounting On A Circuit Board.

Jordan (U.S. Pat # 4,065,198) discloses an LED Mounting Retainer And Display.

Kaufman (U.S. Pat # 4,583,807) discloses a Surface Mount Connector.

Savage Jr. (U.S. Pat # 4,727,648) discloses a Circuit Component Mount And Assembly.

Brzozowski (U.S. Pat # 3,909,096) discloses a Lamp Socket For Use With Printed Circuits And The Like.

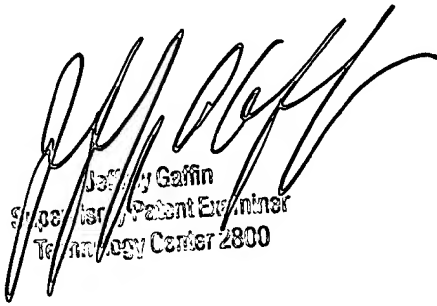
### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh S Phan whose telephone number is 703-305-0069. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Gaffin can be reached on 703-308-3301. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7722 for regular communications and 703-305-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Thanh S. Phan  
Patent Examiner  
June 4, 2001



Jeffery Gaffin  
Supervisor, Patent Examiner  
Technology Center 2800